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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,558	05/16/2006	Motoji Ohmori	2006_0739A	3255
52349 7590 10/31/2008 WENDEROTH, LIND & PONACK L.L.P. 2033 K. STREET, NW SUITE 800 WASHINGTON, DC 20006			EXAMINER NIGH, JAMES D	
			ART UNIT 3685	PAPER NUMBER
			MAIL DATE 10/31/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/579,558	<b>Applicant(s)</b> OHMORI ET AL.	
	<b>Examiner</b> JAMES NIGH	<b>Art Unit</b> 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 16 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>16 May 2006</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This communication is in response to application filed on 16 May 2006. Claims 1-13 are presented for examination on the merits.

#### ***Examiner's Comment***

2. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

This list of examples is not intended to be exhaustive.

MPEP §2106 II C

3. Examples of intended use language found within the claims include:

"while ensuring security of the license information" (claims 1, 8 and 11)

"whose security is secured" (claims 1, 8 and 11)

"in accordance with a use of digital content" (claims 2, 9 and 12)

4. Examples of non-functional descriptive material include:

"which can identify license information and information indicating an update history of the license information" (claim 3)

"based on the data to which a digital signature is applied stored in said signature data storage unit and the correspondence table stored in said correspondence table storage unit" (claim 3)

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“indicating the number of updates or the or the random number when updating the license information (claim 4).

“concerning the information indicating the updated number of updates or the random number in said storage unit” (claim 4).

“defining a condition indicating a range in which the digital content can be used “ (claim 5)

“which is judged as new” (claim 6)

“which can identify the license information and information indicating an update history of the license information” (claim 10)

“based on data to which a digital signature is applied stored in the signature data storage unit and the correspondence table” (claim 10)

“indicating a correspondence between identification information which can identify the license information and information indicating an update history of the license information” (claim 13).

“stored in the signature data storage unit and the correspondence table” (claim 13)

***Priority***

5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

6. The information disclosure statement (IDS) was submitted on 16 May 2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

9. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

10. Claim 6 recites "transfer of the license" but does not indicate that the license is being transferred to any other device ("An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...", *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)).

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**12. Claims 1, 8 and 11 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hori et al. (U.S. Patent PG Publication 2002/0184154, now U.S. Patent 7,340,055, hereinafter referred to as Hori).**

Per the following claims Hori discloses

13. As per claims 1, 8 and 11

data management unit to manage license information (0058, 0082, 0085, 0104, 0136, 0177, 0199, 0204, 0210, 0215-0216, 0218, 0239, 0256)

storage unit to hold license information (0104, 0136, 0177, 0199, 0204, 0210, 0215-0216, 0218, 0239, 0256)

secret key unit to store secret key (0013, 0015, 0176)

reproduction condition management or copy subunit to encrypt license with secret key and transfer to license storage unit (0085, 0118, 0148, 0152-0153, 0158, 0169, 0229, 0231)

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2-7, 9-10 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hori.

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16. As per claims 2, 9 and 12

Hori explicitly discloses reproduction condition management or copy unit includes reading subunit to read license information and secret key (0069, 0070, 0072, 0085-0086, 0093, 0102, 0113-0116, 0118, 0256)

Hori explicitly discloses decryption subunit to decrypt license information with license key (0075, 0099-0100, 0103, 0132, 0134-0136, 0176-0177, 0199, 0204, 0235-0236, 0238-0239)

Hori explicitly discloses information update subunit (0074, 0077)

Hori explicitly discloses overwriting subunit encrypts license information with secret (private) key and stores (0085, 0086, 0102, 0114, 0256)

Hori does not explicitly disclose updating the count when content is used. However, Hori teaches a field for maintaining the count. "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

17. As per claims 3, 10 and 13

Hori explicitly discloses signature data (0222-0227, 0246)

Hori explicitly discloses signature verification (0227)

Hori explicitly discloses a correspondence table (0074, 0082, 0087, 0095, 0096, 0103, 0127-0128, 0131, 0169-0170, 0231-235)

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Hori does not explicitly disclose applying the digital signature to the license ID and usage data. However, Hori teaches digital signatures (0222-0227, 0246) and license ID and usage data (0058, 0082, 0085, 0104, 0136, 0177, 0199, 0204, 0210, 0215-0216, 0218, 0239, 0256). "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Hori does not explicitly disclose storing the digitally signed license ID and usage data. However, Hori teaches storage (0104, 0136, 0177, 0199, 0204, 0210, 0215-0216, 0218, 0239, 0256) "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

18. As per claim 4

Hori discloses an update history as a count (0074)

Hori does not explicitly disclose the act updating the history or the correspondence table . However, Hori teaches a field for updating the history (0074, 0218) and a correspondence table (0074, 0082, 0087, 0095, 0096, 0103, 0127-0128, 0131, 0169-0170, 0231-235). "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).



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19. As per claim 5

Hori discloses encrypted content 0011-0012, 0015-0016, 0018, 0047, 0065, 0069, 0095, 0103, 0127, 0140-0141, 0169, 0180-0182, 0186-0187, 0231, 0242-0243)

Hori discloses reproduction information includes usage information (0074, 0218)

Hori explicitly discloses reproduction information includes a content key (0065, 0069, 0071, 0074, 0082, 0087, 0094-0095, 0103, 0127-0129, 0132, 0134-0136, 0140-0141, 0169-0171, 0173-0174, 0176-0177, 0180-0181, 0186-0187, 0199, 0204, 0218, 0231-0233, 0235-0236, 0238-0239, 0242-0243, 0249, 0251, 0253, 0256)

20. As per claim 6

Hori discloses a reproduction condition management subunit encrypts (0069-0070, 0072, 0085-0086, 0093, 0102, 0113-0116, 0118, 0256) and transfers license (0104, 0136, 0177, 0199, 0204, 0210, 0215-0216, 0218, 0239, 0256)

Hori does not explicitly disclose an information judgment subunit to determine if license is new. However, Hori teaches a reception log being generated when the license is being downloaded ("or new") (0012, 0015-0016, 0018, 0105, 0137, 0147-0148, 0166-0169, 0178, 0194, 0198-0199, 0204, 0208-0210, 0215, 0219, 0240). "One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

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21. As per claim 7

Hori explicitly discloses data management unit is an IC card (background (0007-0008), 0011, 0019, 0049 0053, 0056, 0058, 0068-0070, 0072, 0074-0075, 0077-0080, 0086-0087, 0093-0094, 0098-0107, 0110, 0112, 0114, 0117-0126, 0129-0130, 0133-0134, 0141-0143, 0148, 0150-0156, 0161-0166, 0171-0175, 0181-0182, 0187-0188, 0191, 0194-0198, 0208-0211, 0215, 0220, 0224, 0228, 0233-0234, 0237, 0243-0244, 0252, 0256-0258)

Hori does not explicitly disclose that the storage unit is flash memory. However, Hori teaches that the memory can be read and written to which is a characteristic of flash memory (background (0007-0008), 0011, 0019, 0049 0053, 0056, 0058, 0068-0070, 0072, 0074-0075, 0077-0080, 0086-0087, 0093-0094, 0098-0107, 0110, 0112, 0114, 0117-0126, 0129-0130, 0133-0134, 0141-0143, 0148, 0150-0156, 0161-0166, 0171-0175, 0181-0182, 0187-0188, 0191, 0194-0198, 0208-0211, 0215, 0220, 0224, 0228, 0233-0234, 0237, 0243-0244, 0252, 0256-0258)

"One of the ways in which a patent's subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent's claims", *KSR International Co. v.*

*Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

Please note:

Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the

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specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) (“As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.”).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES NIGH whose telephone number is (571)270-5486. The examiner can normally be reached on Monday-Thursday 6:45-5:15.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JDN

/Jalatee Worjloh/  
Primary Examiner, Art Unit 3685